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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,698

07/09/2003

Andreas Lesche

GK-ZEI-3204 /
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7590

11/22/2004

EXAMINER

MARTINEZ, JOSEPH P

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ART UNIT

PAPER NUMBER

2873

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,698

Applicant(s)

LESCHE, ANDREAS

Examiner

Joseph P. Martinez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekine et al. (5572372).

Re claim 1, Sekine et al. teaches for example, displaceable optics in microscope illumination, comprising: an outer guide sleeve (lens barrel 41, fig. 9A); a cylindrical optics housing (optical system holding member 51, fig. 9A) which slides in the guide sleeve; and Teflon being provided between the optics housing and guide sleeve (col. 5, ln. 39-44) for flexible centering of the optics.

But, Sekine et al. fails to implicitly teach the Teflon in the form of strips.

However, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses the use of an “iron piece adhesively secured to the outer peripheral surface of the optical system holding member 51 and the surface thereof may be Teflon-worked to make it readily slidable” (col. 5, ln. 39-44) to disclose the use of Teflon in any manner to facilitate sliding, including the use of Teflon in the form of strips.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Teflon in the form of strips for ease of manufacturing.

Re claims 2-5 and 8, Sekine et al. further teaches for example, displaceable optics as disclosed above, including the use of Teflon.

But, Sekine et al. fails to implicitly teach Teflon strips arranged in parallel to the displacing direction of the optics housing, provided in pairs opposite one another, wherein an odd or even quantity of Teflon strips are uniformly distributed over the circumference of the optics housing, wherein the Teflon strips are provided at 120 degree offset relative to one another with respect to the circumference or wherein the Teflon strips are glued on.

However, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses the use of an "iron piece adhesively secured to the outer peripheral surface of the optical system holding member 51 and the surface thereof may be Teflon-worked to make it readily slidable" (col. 5, ln. 39-44) to disclose the use of Teflon in any manner to facilitate sliding, including the use of Teflon in the form of strips glued and situated in various manners.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Teflon in the form of strips for ease of manufacturing.

Re claims 6-7, Sekine et al. further teach for example, the Teflon is arranged at the guide sleeve and at the optics housing (col. 5, ln. 39-44, wherein the office interprets the Teflon to be at the point where the optical system holding member 51 and fixed portion 42 interact and therefore meet the claimed limitations).

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2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekine et al. (5572372) in view of Kanao (6690510).

Re claim 9, Sekine et al. teaches for example, in a microscope for examining a sample, a displaceable optics in microscope illumination, comprising: an outer guide sleeve (lens barrel 41, fig. 9A); a cylindrical optics housing (optical system holding member 51, fig. 9A) which slides in the guide sleeve; and Teflon being provided between the optics housing and guide sleeve (col. 5, ln. 39-44) for flexible centering of the optics.

But, Sekine et al. fails to explicitly teach the cylindrical optics housing is adapted to receive illumination from an illumination light source for a microscope and the Teflon is in the form of strips.

However, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses the use of an “iron piece adhesively secured to the outer peripheral surface of the optical system holding member 51 and the surface thereof may be Teflon-worked to make it readily slidable” (col. 5, ln. 39-44) to disclose the use of Teflon in any manner to facilitate sliding, including the use of Teflon in the form of strips.

Furthermore, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses “an optical apparatus provided with a driving unit for moving a lens unit for zooming or focusing or both in a portion of a lens barrel” (col. 1, ln. 12-14) to suggest other uses than in a camera.

Furthermore, within the same field of endeavor, Kanao teaches for example in fig. 1 and 2, the cylindrical optics housing (col. 3, ln. 54-56) is adapted to receive illumination from an illumination light source (801) for a microscope.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Teflon in the form of strips for ease of manufacturing and modify the teachings of Sekine et al. with the Kanao to adapt the optics housing to receive illumination from an illumination light source for a microscope in order to provide a microscope for observing a sample.

Response to Arguments

Re applicant's arguments on p. 8-17-04, wherein the applicant argues that Sekine et al. (5572372) does not describe the displaceable optics for use in microscope illumination, have been considered, but are not persuasive.

In response to applicant's argument that the prior art does not describe the displaceable optics for use in microscope illumination, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph P. Martinez whose telephone number is 571-272-2335. The examiner can normally be reached on M-F 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM

11-14-04



Hung Xuan Qing
Primary Examiner